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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,673	07/20/2001	Yoram Yaacovi	MSFT-0314/164088.1	1516

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EXAMINER

ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/909,673

Applicant(s)

YAACOVI, YORAM

Examiner

Pierre E. Elisca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This Office action is in response to Applicant's Response, filed on 4/26/2004.
2. Claims 1-46 are pending.
3. The rejection to claims 1-46 under 35 U.S.C. 102 (b) as being anticipated by Stefik (U.S. Pat. No. 5,715,403) as set forth in the Office action mailed on 1/9/2004 is maintained.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-46 are rejected under 35 U.S.C. 102 (b) as being anticipated by Stefik (U.S. pat. No. 5,715,403).

As per claims 1, 6, 10-15, 20, 21, 25, 27-32, and 38-44 Stefik discloses a system for ensuring that licenses are in place for using licensed products (which is readable as Applicant's claimed invention wherein said a method for providing to a first content package having a first license associated therewith), the method comprising:

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Receiving first data indicative of the first license, wherein the first license specifies one or more terms governing the relicensing of the content package (see., abstract, col 2, lines 21-44, col 9, lines 19-31, col 44, lines 33-55); and

Licensing the first content package for use on the first computing device in accordance with said one or more terms (see., abstract, col 2, lines 21-44, col 9, lines 19-31, col 44, lines 33-55, and one or more terms or conditions see., col 4, lines 14-24, specifically conditions to exercising the right or if license fees have not been paid). Stefik further discloses the encryption keys (see., col 15, lines 24-54).

As per claims 2 and 3 Stefik discloses the claimed method of determining that licensure of the first content package for use on the first computing device is consistent with a first of said one or more terms (see., abstract, col 2, lines 21-44, col 9, lines 19-31, col 44, lines 33-55, and one or more terms or conditions see., col 4, lines 14-24, specifically conditions to exercising the right or if license fees have not been paid).

As per claims 4, 5, 18, 19, 22, 23, and 26 Stefik discloses the claimed method wherein said terms requires collection of a payment as a condition of licensing the first content package for use on the first computing device, and wherein said action comprises collecting said payment (see., col 2, lines 21-44).

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As per claim 7, 8, 9, 16, 17, 24, 33-37, and 45-46 Stefik discloses the claimed method wherein the content package comprises a content portion and the first license (or repository, figs 1 and 2), and wherein said licensing act comprises:

Creating a second content package which comprises:

Said content portion (or repository); and

A second (or usage rights associated with repository 2) which permits access to said second content package on the first computing device (see., col 7, lines 16-48, figs 1 and 2); and transmitting said second content package to the first computing device (see., col 7, lines 16-48, figs 1 and 2, col 8, lines 1-32).

RESPONSE TO ARGUMENTS

6. Applicant's arguments filed on 4/26/2004 have been fully considered but they are not persuasive.

REMARKS

7. In response to Applicant's arguments, Applicant argues that:

a. "None of the cited portions teach or suggest the act of licensing of a digital work". Based upon foregoing rejection detailed above, it is believed that Stefik discloses this limitation in the abstract, col 2, lines 22-44, specifically wherein said the present invention allows an owner of a digital work to attach rights (attach right or digital license) to their work (or content package), and ensuring that licenses are in place for using licensed products (product or content package).

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b. "How the cited portion teach the licensing of content in accordance with the terms". As indicated above, Stefik discloses this limitation in the abstract, col 2, lines 21-44, col 9, lines 19-31, col 44, lines 33-55, and one or more terms or conditions see., col 4, lines 14-24, specifically conditions to exercising the right or if license fees have not been paid, and also col 21, lines 66 and 67, col 22, lines 1-9).

c. In response to claims 4, 5, 18, 22, 23, 32, 44, and 45, Applicant argues that the prior art of record does not teach or suggest: "collection of a payment as a condition of licensing the first content package for use on the first computing device, and wherein said action comprises collecting said payment". As noted above, Stefik discloses this limitation in col 2, lines 21-44.

d. In response to claims 6, 19, 24, 33, and 46, Applicant argues that the prior art of record fails to disclose: "call for a license term governing the creation of a license". However, the Examiner respectfully disagrees since Stefik discloses this limitation in the abstract, col 2, lines 21-44, col 9, lines 19-31, col 44, lines 33-55.

e. In response to claims 8 and 37, Applicant argues that the prior art of record fails to disclose: "A second (or usage rights associated with repository 2) which permits access to said second content package on the first computing device". However, the Examiner respectfully disagrees because Stefik discloses this limitation in col 7, lines 16-48, figs 1 and 2, and transmitting said second content package to the first computing device (see., col 7, lines 16-48, figs 1 and 2, col 8, lines 1-32).

Conclusion

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8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

Primary patent examiner

July 20, 2004